

REMARKS

The present application includes pending claims 1-5, 7-10 and 12-23, all of which have been rejected.

Claims 2 and 3 were objected to under 37 CFR 1.75(c) because “the language of these claims [is] purely functional.” *See* October 8, 2008 Office Action at page 4. Initially, the only authority the Office Action cites for this objection is 37 CFR 1.75(c). *See id.* There is nothing in this section that precludes functional language in a claim. Indeed, the Manual of Patent Examining Procedure (MPEP) specifically states that “features of an apparatus may be recited either structurally or functionally....” *See* MPEP at 2114. “There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.” *See* MPEP at 2173.05(g). Thus, the Applicant respectfully requests reconsideration of these claim objections.

Next, claims 1-5, 7-10 and 12-23 are objected to because “[i]t is unclear what is meant by the relative motion [being] asymmetrical.” *See* October 8, 2008 Office Action at page 4. The Applicant respectfully submits, however, that asymmetrical relative motion is clearly described in the present application at, for example, ¶¶[0040] – [0041] (“Movement of either the medical instrument 16 or the headset 12 causes relative motion between the two. ... That is, movement from one point to the other is asymmetrical.”) Thus, the Applicant respectfully requests reconsideration of these claim objections.

Nevertheless, in an effort to expedite prosecution, the Applicant may be willing to amend the claims to recite, for example, “relative motion among said transmitter coil trio, said receiver coil trio and said single coil is asymmetrical, wherein the asymmetrical relative motion alleviates alleviating hemisphere ambiguity.” Such an amendment would not raise any new issues that would require a further search due to the fact that the claim would be broader in scope and the Examiner already has searched the narrower subject matter. That is, a search of limitations A, B, C and D necessarily yields results for just A, B and C. If such an Amendment would expedite prosecution towards allowance, the Applicant invites the Examiner to contact the undersigned attorney.

Claims 1-5, 7-8, 10, 12-13, 15, 17 and 19-23 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 6,266,552 (“Slettenmark”). Claims 9, 14, 16 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Slettenmark in view of U.S. 5,800,352 (“Ferre”). The Applicant respectfully traverses these rejections for at least the reasons previously discussed during prosecution and the following:

As an initial matter, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel **should state all reasons and bases for rejecting claims in the first Office action.** Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. **Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved.** A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See MPEP at 2106(II) (emphasis added). As such, the Applicant assumes, based on the goals of patent examination noted above, that *this* Office Action has set forth “all reasons and bases” for rejecting the claims.

Further, **this Response does not amend any of the claims.** Therefore, the Applicant respectfully submits that this Response cannot raise any new issues with respect to the pending claims that would require a further search. In short, a never-ending process of repeatedly dredging up different prior art references after the Applicant effectively differentiates cited references without amending claims unquestionably undermines the principles of compact prosecution.

The Applicant now turns to the rejection of claims 1-5, 7-8, 10, 12-13, 15, 17 and 19-23 as being anticipated by Slettenmark. “A claim is anticipated only if **each and every element** as

set forth in the claim is found, either expressly or inherently described, in **a single prior art reference.**” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The **identical** invention must be shown in as complete detail as is contained in … the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Claim 1 recites, in part, “a transmitter assembly having a transmitter coil trio; a receiver assembly having a receiver coil trio, wherein one of said transmitter assembly and said receiver assembly is positioned on a medical instrument and the other of said receiver assembly and said transmitter assembly is configured to be positioned on a patient; a single coil mounted on one of said receiver assembly and said transmitter assembly.” Thus, the claim is clear that the transmitter assembly includes a transmitter coil **trio**, the receiver assembly includes a receiver coil **trio**, and a **single coil**, not a coil trio, is mounted on the receiver assembly or the transmitter assembly.

Slettenmark discloses that “two **triaxial coils 32, 34** are mounted” on a catheter 30, while “there is one similar **triaxial** receiving or pickup coil system” on catheter 36. *See* Slettenmark at column 4, lines 31-52 (emphasis added). Thus, one catheter has two **triaxial** coils, while the other has one **triaxial** coil. Slettenmark does not describe, teach or suggest, however, “a transmitter assembly having a **transmitter coil trio**; a receiver assembly having a **receiver coil trio**, wherein one of said transmitter assembly and said receiver assembly is positioned on a medical instrument and the other of said receiver assembly and said transmitter assembly is configured to be positioned on a patient; **[and] a single coil mounted on one of said receiver assembly and said transmitter assembly.**” That is, Slettenmark does not describe, teach or suggest a single coil on either catheter in addition to the triaxial coils 32, 34 or 36.

Slettenmark does state, however, the following:

A minimum requirement for determining the desired position and direction of the measurement and/or treatment catheter is realized by a configuration using three coils on the fixed catheter. One preferred embodiment includes the use of [1] one crossed biaxial coil system and a single coil separated along the catheter as described above. However, other configurations are possible, e.g.,

a [2] single orthogonal triaxial coil system or [3] three single coils arranged in a suitable configuration. By using[4] two triaxial coils as described above the accuracy of the determination can be further improved.

Id. at column 6, lines 36-45 (emphasis added). Thus, Slettenmark requires three coils on the fixed catheter. In one embodiment, a biaxial coil system and a single coil are used. Alternatively, one single triaxial coil system may be used. Also, alternatively, three single coils may be used. Also, alternatively, as discussed above, two triaxial coils may be used. However, Slettenmark simply does not describe, teach or suggest any embodiment including “a transmitter assembly having a **transmitter coil trio**; a receiver assembly having a **receiver coil trio**, wherein one of said transmitter assembly and said receiver assembly is positioned on a medical instrument and the other of said receiver assembly and said transmitter assembly is configured to be positioned on a patient; **[and] a single coil mounted on one of said receiver assembly and said transmitter assembly**,” as recited in claim 1. Independent claims 10, 15, 21, 22 and 23 recite similar limitations. Thus, for at least these reasons, the Applicant respectfully submits that Slettenmark does not anticipate any of the pending claims of the present application.

The Applicant also respectfully submits that the proposed combination of Slettenmark and Ferre does not render claims 9, 14, 16 and 18 unpatentable for at least the reasons discussed above.

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. The Applicant expressly reserves the right, however, to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a future claim rejection).

The Applicant respectfully submits that the pending claims of the present application define patentable subject matter, and request reconsideration of the claim rejections. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the undersigned attorney for the Applicant.

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Response Under 37 C.F.R. § 1.111
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The Commissioner is authorized to charge any necessary fees, or credit any overpayment to Account No. 07-0845.

Respectfully submitted,

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